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UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA  
SAN JOSE DIVISION

ZINUS, INC. a California Corporation,

Plaintiff,

v.

SIMMONS BEDDING COMPANY, a  
Delaware corporation, and DREAMWELL,  
LTD., a limited liability company of  
Nevada,

Defendants.

Case No. 07-CV-03012-PVT

**DREAMWELL'S MEMORANDUM IN  
OPPOSITION TO PLAINTIFF ZINUS INC.'S  
MOTION FOR RECONSIDERATION**

**Date:** January 22, 2008  
**Time:** 10:00 a.m.  
**Before:** The Honorable Patricia V. Trumbull  
**Location:** Courtroom 5

AND RELATED COUNTERCLAIMS

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## Introduction

Plaintiff and counterclaim defendant Zinus, Inc.'s ("Zinus") Motion for Reconsideration is premised on an issue that was raised for the first time in Zinus' Reply Brief in support of its original Motion for Summary Judgment<sup>1</sup>: whether the doctrine of prosecution history estoppel precludes defendant and counterclaimant Dreamwell, Ltd. ("Dreamwell") from arguing that Zinus' use of the combination of a sheet of reinforced fabric and bands of tape or plastic stripping to prevent the compressed mattress from expanding during shipping is the equivalent of a containment sleeve. However, Zinus' motion skips over the fundamental question of whether prosecution history estoppel even applies to the claimed equivalent in question.

In particular, Zinus' argument appears to suggest (without any legal basis) that if a claim element is modified, the components or terms within that element are not entitled to any scope of equivalents. But the law is clear, and is properly stated (albeit not properly applied) at page 11 of Zinus' Motion for Reconsideration: "any 'equivalent' that was within the scope of the claim before amendment, and that is not within the scope of the claim after amendment, is presumed to have been surrendered." *See also Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 493 U.S. 1368 (Fed. Cir. 2007) (*Festo 2007*) (emphasis added) ("A patentee's decision to narrow his claims through amendment may be presumed to be a general disclaimer *of the territory between the original claim and the amended claim*"). In other words, prosecution history estoppel only serves as a limitation on the doctrine of equivalents to the extent an accused device or method falls between the scope of the element as originally drafted and the scope of the claim as ultimately issued.

Here, both Zinus' moving papers and the patent file history plainly demonstrate that the only relevant amendment involved narrowing the subject of the patented method from generic "compressed articles" to a specific mattress assembly "of coiled springs wherein each spring is

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<sup>1</sup> Dreamwell submits that it is improper for Zinus to bring a "Motion for Reconsideration" based on an argument raised for the first time in its Reply papers, and further notes that Zinus has failed to make any showing that it is entitled to seek reconsideration, as required by Local Rule 7-9. However, since the Court has already granted Zinus leave to bring this motion, Dreamwell has limited its Opposition to the merits of Zinus' Motion.

1 contained within an individual pocket of fabric.” There was never any modification to the  
2 “containment sleeve” language itself. Thus, while the doctrine of prosecution history estoppel  
3 might impact Dreamwell’s ability to argue under the doctrine of equivalents that its claims cover  
4 a compressed article other than a pocketed coil innerspring mattress, it has no effect on the scope  
5 of equivalents for the containment sleeve. Moreover, even if Dreamwell could somehow be  
6 presumed to have surrendered some range of equivalents with respect to the containment sleeve,  
7 the scope of subject matter surrendered could not as a matter of law be construed broadly enough  
8 to preempt Dreamwell’s doctrine of equivalents claim.

9 Once the law is properly applied, it is clear that the doctrine of prosecution history  
10 estoppel has no applicability to Dreamwell’s doctrine of equivalents argument. Indeed, the  
11 governing case law demonstrates as a matter of law that Zinus’ prosecution history estoppel is  
12 legally and factually without merit. Accordingly, Dreamwell respectfully submits that Zinus’  
13 Motion for Reconsideration must be denied.

#### 14 **Statement of Relevant Facts**

15 Although many of the facts relating to Zinus’ Motion for Reconsideration were set forth in  
16 Dreamwell’s original Opposition to Zinus’ Motion for Partial Summary Judgment (the “Summary  
17 Judgment Opposition”), certain of the facts were not. Moreover, because prosecution history  
18 estoppel was not raised as an issue until Zinus’ Summary Judgment Reply Memorandum,  
19 Dreamwell’s Summary Judgment Opposition did not present the facts with an eye to that defense.  
20 As a result, Dreamwell submits the following summary of facts that have particular relevance to  
21 the prosecution history estoppel issue.

#### 22 **Background of the ‘142 Patent**

23 As noted in Dreamwell’s original Opposition to Zinus’ Motion for Partial Summary  
24 Judgment, the ‘142 Patent provides an improved method of packaging for shipment a particular  
25 type of innerspring mattress assembly (i.e., a mattress assembly “wherein each spring is contained  
26 within an individual pocket of fabric”). [See, e.g., Declaration of Kenneth B. Wilson in  
27 Opposition to Plaintiff Zinus, Inc.’s Motion for Summary Adjudication of Non-Infringement  
28

1 (“Wilson Decl.”), Exh. 1 (‘142 Patent, 4:6-8, 4:43-45, 5:1-3, 5:25-59, 6:9-11)]<sup>2</sup> Such mattresses  
 2 “are lightweight and bulky and cannot be delivered to the consumer without an undesirably high  
 3 cost associated with shipment,” which “adversely affect[s] the perceived value of the article to the  
 4 consumer.” [*Id.* (‘142 Patent, 1:22-28)] To address these issues, the ‘142 Patent discloses a  
 5 method of packaging this particular type of innerspring mattress for shipment in a compressed  
 6 state, thereby simplifying and reducing the cost of shipping (and therefore potentially the cost to  
 7 consumers) of the product. [*See id.* (‘142 Patent, 1:15-20)]

8 On April 4, 1995, inventors C. Edward Steed and Rickey F. Gladney filed the application  
 9 on which the ‘142 Patent was based. [Wilson Decl. Exh. 1 (‘142 Patent, p. 1)] The original  
 10 application contained four claims (one independent and three dependent), which sought broad  
 11 coverage of a method of packaging a “resiliently compressible article,” rather than innerspring  
 12 mattresses. [Exh. W-F]<sup>3</sup> Accordingly, each of the claims included the step of placing the generic  
 13 “compressible article” into a tube of deformable material, which was subsequently evacuated, as  
 14 well as the following element: “inserting said evacuated tube into a containment sleeve which is  
 15 dimensioned and configured to retain said *compressed article* in a compressed state.” [*Id.* (the  
 16 italicized phrase is the term in this element that was ultimately amended in the ‘142 Patent  
 17 claims)]

18 In its initial Office Action, the Patent Office rejected all four claims of the original  
 19 application as obvious in light of the Broyles prior art reference, which related to a process of  
 20 putting mattress springs into a cover. [Exh. W-F] In January 1996, the inventors therefore  
 21 submitted a response to this Office Action in which they amended the object of the claimed  
 22 process from a “resiliently compressible article” to an “assembly of coiled springs wherein each  
 23 spring is contained within an individual pocket of fabric.” Similarly, the element at issue was  
 24 amended to read as follows: “inserting said evacuated tube into a containment sleeve which is

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25 <sup>2</sup> Rather than burden the Court with additional paper, and since this is a Motion for  
 26 Reconsideration, Dreamwell’s evidentiary citations are to the Declarations filed in connection with Zinus’  
 27 underlying Motion for Partial Summary Judgment. Moreover, as was the case with the original Motion,  
 when referring to the ‘142 Patent, “X:Y-Z” refers to column X, lines Y-Z of the patent.

28 <sup>3</sup> Citations to exhibits beginning with “Exh. R” or “Exh. W” refer to Exhibits to the Declarations  
 submitted by plaintiff Zinus in support of its original motion.

1 dimensioned and configured to retain said *compressed assembly* in a compressed state.” .” [*Id.*  
2 (again, the italicized phrase is the term in this element that was ultimately amended in the ‘142  
3 Patent claims)] In other words, the only modification to the “containment sleeve” element was to  
4 change the word “article” to “assembly.” The inventors made no amendment to the “containment  
5 sleeve” language itself. In fact, the language “inserting said evacuated tube into a containment  
6 sleeve which is dimensioned and configured to retain” remained unchanged throughout the  
7 prosecution of the patent.

8 In presenting their patentability argument, the inventors reinforced that the subject matter  
9 of the amendment was the type of article to be packaged, noting that “[i]n an effort to distinguish  
10 even more clearly over Broyles, claim 1 has been amended herein to specifically recite a method  
11 of packaging *pocketed* coils.” [Exh. W-F (emphasis in original)] To support their argument that  
12 a mattress assembly in which each spring is contained within an individual pocket of fabric  
13 differs significantly from other types of mattresses (such as the Broyles mattress), the applicants  
14 submitted the Declaration of co-inventor Ricky F. Gladney. [*Id.* (Declaration of Ricky F.  
15 Gladney Under Rule 1.132 (“Gladney Decl.”))] In this Declaration, Mr. Gladney detailed the  
16 results of tests that he had conducted which established that the use of pocketed coil spring  
17 assemblies with the other steps of the claimed method achieved substantial and unexpected  
18 benefits over utilizing those steps with the prior art Broyles mattress assembly, which did not  
19 contain pocketed coils. [*Id.* (Gladney Decl. at ¶¶ 6-9)]

20 Notwithstanding these arguments, the Patent Office issued a “final rejection “of all claims  
21 in light of the Broyles patent. [Exh. W-F] In response, on or about June 26, 1996, the inventors  
22 submitted an Amendment After Final Rejection in which they again narrowed the type of material  
23 to be packaged, this time from “an assembly of coil springs” to “a mattress assembly constructed  
24 of coil springs.” The inventors correspondingly added the highlighted language to the  
25 “containment sleeve” element: “inserting said evacuation tube into a containment sleeve which is  
26 dimensioned and configured to retain said *mattress assembly* in a compressed state *for*  
27 *shipment*.” [*Id.*] However, once again, the inventors did not offer any amendments that would  
28 narrow or “surrender” any subject matter relating to the containment sleeve.

1 On October 30, 1996, after the inventors filed a continuation application containing the  
 2 four claims from the June 26, 1996 Amendment and abandoned the original application, the  
 3 Patent Office finally issued a Notice of Allowability confirming that the twice amended claims  
 4 were patentable. [Exh. W-E] On April 22, 1997, the Patent Office issued U.S. Patent No.  
 5 5,622,030 (the “‘030 Patent”), which included these claims. [Id.]

6 Roughly four months after the ‘030 Patent issued, the inventors filed an application for a  
 7 broadening reissue of the patent, based on errors in the original application. The new application  
 8 contained a broader version of original independent claim 1, as well as five new dependent claims  
 9 that provided variations on the original patented method. Neither the modified claim 1 nor the  
 10 new dependent claims (for of which ultimately issued as independent claims) contained any  
 11 modification to the element at issue in this motion, or otherwise narrowed the scope of the  
 12 claimed “containment sleeve”.

13 On March 16, 1999, with only slight technical modifications that are irrelevant to this  
 14 motion, these claims “reissued” as the ‘142 Patent. [Exh. W-D]

#### 15 Zinus’ Accused Swirl Wrap Process

16 According to Zinus’ Amended Complaint, some seven years after issuance of the ‘142  
 17 Patent, Zinus introduced its original Mattress-in-a-Box product in about 100 Wal-Mart stores.  
 18 [Third Amended Complaint ¶ 20] Zinus’ original Mattress-in-a-Box product was packaged for  
 19 shipping in a “polyethylene duffel bag, the purpose of which (in the words of Zinus’ President,  
 20 Scott Reeves) was “to limit or prevent the expansion of the compressed mattress” during  
 21 shipping. [Wilson Decl. Exh. 2 (Deposition Transcript of Scott Reeves (“Reeves Depo.”), 33:7-  
 22 10)]<sup>4</sup>

23 After receiving notice of Dreamwell’s infringement claim, Zinus decided to replace the  
 24 polyethylene duffel bag, and to instead use a combination of reinforced fabric and banding tape or  
 25 plastic stripping to limit the expansion of the compressed mattress, in what Zinus refers to as the  
 26 “Swirl Wrap” process. As part of this process, a compressed mattress is placed onto a rectangular  
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28 <sup>4</sup> When citing to the deposition transcript of Scott Reeves, “X:Y-Z” refers to page X, lines Y-Z.



1 sheet of flexible film or fabric that is slightly wider than the mattress, and is manually rolled up  
 2 into the sheet of fabric. [Wilson Decl. Exh. 2 (Reeves Depo., 28:8-20, 30:11-19)] In one  
 3 embodiment of this process, adhesive tape is wrapped around the outside of the fabric roll,  
 4 adhering to the fabric sheet and (along with the fabric sheet) preventing the compressed mattress  
 5 assembly from expanding during shipping. [*Id.* (Reeves Depo., 20:1-24, 28:21-29:11)] In  
 6 another embodiment, instead of adhesive tape, plastic stripping is wrapped around the rolled up  
 7 mattress to secure it. [*Id.* (Reeves Depo., 20:1-24, 38:23-40:4)] The bundled assembly is then  
 8 placed into a box for shipment. [*Id.* (Reeves Depo., 36:21-37:11)]

9 In the words of Zinus' President, Mr. Reeves, "[t]he flexible film and the tape or bands  
 10 [are] designed to limit the ability of the compressed mattress to expand" during shipping. [Wilson  
 11 Decl. Exh. 2 (Reeves Depo., 20:1-4; *see also* 29:24-30:8, 32:24-33:4)] The way in which Zinus  
 12 perform this function is by providing a barrier (i.e., the combination of the reinforced fabric and  
 13 the bands of tape or plastic stripping) that covers or surrounds a substantial portion of the exposed  
 14 surface of the mattress and that is sufficiently strong to restrict the ability of the compressed  
 15 mattress to expand (i.e., it "holds the mattress"). [*Id.* (Reeves Depo., 20:9-24; *see also* 30:24-31:8  
 16 ("The combination of the flexible film and tape or bands limit the compressed mattress from  
 17 expanding after it was rolled up. . . . [B]oth the flexible film that's reinforced and the strapping  
 18 material combined together to give us a strong hold on that mattress"))] And Mr. Reeves  
 19 confirmed that the result of this combination is that it gives Zinus "a very stable product . . . , one  
 20 that will not expand" during shipping. [*Id.* (Reeves Depo., 20:5-24 ("The combination of the  
 21 film and the tape or the bands [is] effective in limiting the ability of the compressed mattress to  
 22 expand"))]

23 Dreamwell's technical expert further corroborated Mr. Reeves' testimony regarding the  
 24 function and structure of the accused equivalent. [See Expert Declaration of Michael S. DeFranks  
 25 in Opposition to Plaintiff Zinus, Inc.'s Motion for Summary Adjudication of Non-Infringement  
 26 ("DeFranks Decl."), ¶¶ 12-19 ("the Swirl Wrap process also performs the function of preventing  
 27 or restricting the compressed mattress from expanding during shipment by providing a barrier that  
 28 covers or surrounds a substantial portion of the exposed surface of the mattress (in the form of the

combination of the reinforced fabric sheet and the ribbon-shaped bands of adhesive tape or plastic stripping) and that is sufficiently strong to resist the internal forces of the compressed mattress”)]

### Argument

#### **I. ZINUS CANNOT PREVAIL ON ITS PROSECUTION HISTORY ESTOPPEL DEFENSE AS A MATTER OF LAW**

Zinus’ Motion for Reconsideration does not seek to challenge the general proposition that, in assessing a motion for summary judgment of non-infringement under the doctrine of equivalents, special care must be taken because “[i]nfringement under the doctrine of equivalents requires an intensely factual inquiry.” *See, e.g., Toro Company v. White Consolidated Industries, Inc.*, 266 F.3d 1367, 1370 (Fed. Cir. 2001) (citations omitted) (reversing summary judgment of non-infringement based on doctrine of equivalents); *see also Warner-Jenkinson v. Hilton Davis Chemical Co.*, 520 U.S. 17, 39 n. 8 (1997). Instead, Zinus argues that the Court can bypass this fact-intensive inquiry because Zinus has presented a prosecution history estoppel defense that the Court can decide as a matter of law and that, if decided in Zinus’ favor, could resolve Dreamwell’s doctrine of equivalents claim as it relates to Zinus’ Swirl Wrap packaging process.<sup>5</sup>

Dreamwell agrees that the merits of Zinus’ prosecution history estoppel defense can likely be decided as a matter of law. However, contrary to Zinus’ assertions, the evidence of record mandates that this issue be decided in Dreamwell’s favor.

#### **A. The Law of Prosecution History Estoppel**

Dreamwell agrees with Zinus that the Federal Circuit has provided substantial and detailed guidance on the law of prosecution history estoppel. Specifically, as the Federal Circuit recently summarized (and as reproduced by Zinus at page 1 of its Summary Judgment Reply Memorandum), “[p]rosecution history estoppel limits the broad application of the doctrine of equivalents by barring an equivalents argument *for subject matter relinquished* when a patent

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<sup>5</sup> Although Zinus’ Motion for Reconsideration contains a substantial discussion of Dreamwell’s literal infringement claim, Zinus never moved for a partial summary judgment on that theory of infringement. Rather, Zinus moved for summary judgment on infringement as a whole. Accordingly, and because Dreamwell has presented at least a triable issue of fact on its doctrine of equivalents argument, Dreamwell has not addressed literal infringement in this Opposition.

claim is narrowed during prosecution.” *Conoco, Inc. v. Energy & Environmental Intern., L.C.*, 460 F.3d 1349, 1363 (Fed Cir. 2006).

As Zinus properly recognized at page 2 of its Summary Judgment Reply Memorandum, with respect to amendment-based estoppel (which is the species of prosecution history estoppel that Zinus has asserted),<sup>6</sup> the Supreme Court has stated that “[a] patentee’s decision to narrow his claims through amendment may be presumed to be a general disclaimer *of the territory between the original claim and the amended claim.*” *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 535 U.S. 722, 740-41, 122 S.Ct. 1831, 152 L.Ed.2d 944 (2002) (emphasis added). In other words (in fact, in Zinus’ own words from page 11 of its Motion for Reconsideration), “any ‘equivalent’ that was within the scope of the claim before amendment, and that is not within the scope of the claim after amendment, is presumed to have been surrendered.” On the other hand, the presumption of prosecution history estoppel does not apply to a claim element that is not amended, or to an accused equivalent that was not surrendered as part of a prosecution history amendment.<sup>7</sup> See *AquaTex Industries, Inc. v. Techniche Solutions*, 479 F.3d 1320 (Fed. Cir. 2007).

Even where a claim has been amended in a way that the presumption of prosecution history applies, the Supreme Court has noted in its *Festo* opinion that “[t]here are some cases . . . where the amendment cannot reasonably be viewed as surrendering a particular equivalent. The equivalent may have been unforeseeable at the time of the application; the rationale underlying the amendment may bear no more than a tangential relation to the equivalent in question; or there may be some other reason suggesting that the patentee could not reasonably be expected to have

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<sup>6</sup> There is a second species of prosecution history estoppel, “argument-based estoppel,” but for this type of estoppel to apply, the inventors must “clearly and unmistakably surrender[] subject matter by arguments made to an examiner.” See, e.g., *Aquatex Industries, Inc. v. Techniche Industries*, 419 F.3d 1374 (Fed. Cir. 2005). Here, the ‘142 Patent contains no “clear and unmistakable surrender of subject matter” relating to the containment sleeve, and not surprisingly, Zinus has not asserted that this species of estoppel applies to Dreamwell’s doctrine of equivalents claim.

<sup>7</sup> At page 8 of its Motion for Reconsideration, Zinus erroneously asserts without citation to any case authority that “[t]he patentee is presumed to have disclaimed claim scope to equivalents of amended claim elements. As the U.S. Supreme Court and the Federal Circuit made clear in the *Festo* cases, this statement is overly broad; the patentee is presumed to have disclaimed claim scope, but only “of the territory between the original claim and the amended claim.” As discussed in more detail below, this distinction is critical on the facts of this case.

1 described the insubstantial substitute in question. In those cases the patentee can overcome the  
2 presumption that prosecution history estoppel bars a finding of equivalence.” 535 U.S. at 740-41.

3 Finally, as Zinus correctly notes, as a general matter “[p]rosecution history estoppel as a  
4 limit on the doctrine of equivalents is an issue of law which is reviewed without deference.”  
5 *Festo 2007*, 493 F.3d at 1376 (citations omitted). However, as Zinus also acknowledges at page 9  
6 of the Motion for Reconsideration, the unforeseeability exception to the presumption of  
7 prosecution history estoppel may depend on the resolution of disputed facts issues. *Festo 2007* at  
8 1375 (citations omitted) (“because by its very nature objective unforeseeability depends on  
9 underlying factual issues, district courts may hear expert testimony and consider other evidence  
10 relating to the foreseeability analysis”). Thus, while unforeseeability is an issue to be decided by  
11 the Court, its fact-intensive nature may make it inappropriate to resolve in the context of a  
12 summary judgment motion.

13 **B. The Doctrine of Prosecution History Estoppel Is Inapplicable to the**  
14 **Containment Sleeve Element.**

15 As noted above, the presumption (and therefore the defense) of prosecution history  
16 estoppel only applies to limit a claim of infringement under the doctrine of equivalents where the  
17 accused equivalent was “within the scope of the claim before amendment, and . . . is not within  
18 the scope of the claim after amendment,. Zinus has not argued and cannot seriously argue its  
19 combination of reinforced fabric and bands of tape or plastic stripping was literally covered by  
20 the original claims of the ‘142 Patent, and that the claims were later amended to surrender this  
21 embodiment. In fact, as the ‘142 Patent prosecution history clearly establishes, the “containment  
22 sleeve” language was not substantively narrowed throughout the prosecution of the patent.  
23 Accordingly, while Zinus’ prosecution history defense may be decided as a matter of law, it  
24 should be decided in Dreamwell’s favor.

25 The Federal Circuit’s opinion in *AquaTex Industries, Inc. v. Techniche Solutions*, 479 F.3d  
26 1320 (Fed. Cir. 2007), is controlling on this issue. In *AquaTex*, the district court granted  
27 defendant’s motion for summary judgment of non-infringement, finding in relevant part that  
28 plaintiff’s claim of infringement under the doctrine of equivalents was barred by prosecution

1 history estoppel based on a narrowing amendment made during prosecution of the patent. The  
2 Federal Circuit reversed, holding that “[t]he subject matter surrendered by the narrowing  
3 amendment bears no relation to the composition of the fiberfill batting material,” which was the  
4 basis for plaintiff’s equivalence claim. *AquaTex*, 419 F.3d at 1383. In fact, the Court went on to  
5 observe that the amendment in question “was directed to a completely different claim limitation -  
6 the requirement that the overall method of cooling of the garment be by evaporation.” *Id.* Thus,  
7 the Court reasoned that “AquaTex surrendered no claim to the characteristics of the fiberfill  
8 during prosecution and was not barred from asserting equivalents as to the ‘fiberfill batting  
9 material’ limitation.” *Id.*

10 As was the case in *Aquatex*, while the inventors of the ‘142 Patent did make certain  
11 narrowing amendments (by limiting the subject matter of the method to a mattress assembly  
12 consisting of pocketed coil springs, as opposed to the generic “resiliently compressible articles  
13 that were the original target of the patented method), those amendments did not limit or restrict  
14 the characteristics of the containment sleeve element at issue in this motion. Indeed, as in  
15 *Aquatex*, these amendments were directed to an entirely different aspect than the containment  
16 sleeve, namely the specific type of article or assembly on which the patented method would be  
17 performed. There is no conceivable argument that in making these amendments, the inventors  
18 surrendered coverage of the Zinus combination of fabric and banding tape or plastic stripping.

19 Similarly, while the inventors of the ‘142 Patent modified the claims to clarify that the  
20 function of the containment sleeve was “to retain said mattress assembly in a compressed state *for*  
21 *shipment*,” Zinus has not argued and cannot argue that the addition of the clause “for shipment”  
22 substantively narrowed the scope of the claims at all, let alone that it surrendered subject matter  
23 that would place Zinus’ accused equivalent outside the scope of the ‘142 Patent claims. To the  
24 contrary, Zinus’ President clearly and repeatedly testified that like the containment sleeve, the  
25 purpose of the fabric sheet and tape/plastic stripping combination was to restrict the mattress  
26 assembly from expanding during shipment. [Wilson Decl. Exh. 2 (Reeves Depo., 20:1-4 (“[t]he  
27  
28

flexible film and the tape or bands [are] designed to limit the ability of the compressed mattress to expand” during shipping); *see also* 29:24-30:8, 32:24-33:4)]<sup>8</sup>

In sum, the intrinsic record clearly establishes that Dreamwell surrendered no claim to the characteristics of the containment sleeve during prosecution, and that the doctrine of prosecution history estoppel therefore provides no limitation on Dreamwell’s ability to assert infringement under the doctrine of equivalents with respect to Zinus’ fabric sheet and tape/plastic stripping combination. Dreamwell is entitled to resolution of this issue in its favor as a matter of law.

**C. Even If the Doctrine of Prosecution History Estoppel Applied to the Containment Sleeve Element, It Would Not Preclude Dreamwell from Arguing that the Combination of Fabric and Tape or Bands Constitutes the Equivalent of a Containment Sleeve.**

While Dreamwell is confident that the Court will find that the presumption of prosecution history estoppel is inapplicable on the facts of this case because Dreamwell is not seeking to recapture subject matter that it surrendered during prosecution of the ‘142 Patent, even if the Court were somehow to decide to apply the presumption, Zinus still cannot establish that the prosecution history amendments operate to bar Dreamwell’s doctrine of equivalents claim. . This is because Dreamwell is entitled to the benefit at least two of the *Festo* exceptions to the presumption: 1) the rationale underlying the amendments bears no more than a tangential relation to the equivalent in question; and 2) there is at least a triable issue of fact regarding whether the claimed equivalent would have been unforeseeable at the time of the application.

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<sup>8</sup> The only other amendment that could conceivably impact the scope of equivalents allotted to the “containment sleeve” element is the addition of the element ““removing said evacuated tube from said containment sleeve.” However, while this language may, in the words of the inventors, enable “the structure and functioning of applicants’ containment sleeve [to be] more clearly and specifically defined,” it does not provide any substantive limitation on the containment sleeve element. Zinus has not suggested that this language caused any meaningful narrowing of the containment sleeve element. Indeed, removing the compressed mattress and evacuated tube from the containment sleeve is an inherent characteristic of the claimed invention, since the mattress could not be used for its intended purpose while in the containment sleeve.

1                   1.     **The Rationale Underlying the Narrowing Amendments Bear**  
2                           **No More than a Tangential Relation to Whether the**  
3                           **Combination of Fabric and Banding Tape or Plastic Stripping**  
4                           **Is Equivalent to the Claimed Containment Sleeve.**

5             While Zinus only makes passing reference to the “tangential relation” exception to the  
6     prosecution history estoppel doctrine at pages 12-13 of its Motion for Reconsideration, this  
7     exception relates directly to the doctrine of equivalents claim in question here. As articulated by  
8     the Supreme Court in *Festo*, this exception applies where “the rationale underlying the  
9     amendment [bears] no more than a tangential relation to the equivalent in question. 535 U.S. at  
10    740-41. Put another way, in assessing the availability of this exception, the Court must ascertain  
11    “whether the reason for the narrowing amendment was peripheral, or not directly relevant, to the  
12    alleged equivalent.” *Insituform Technologies, Inc. v. CAT Contracting, Inc.*, 385 F.3d 1360, 1370  
13    (Fed. Cir. 2004). As Zinus correctly noted, this determination is a question of law.

14            The Federal Circuit’s opinion in *Insituform* is instructive. There, the original dependent  
15    claim of the patent-in-suit, which related to a vacuum-based method for performing pipe repair  
16    without taking the damaged pipe out of the ground, did not specify either the position or number  
17    of vacuum cups used in the patented method or the location of the vacuum source. The claims  
18    were amended during prosecution to specify use of a single vacuum cup. The patentee  
19    subsequently argued that a multiple cup process infringed its patent under the doctrine of  
20    equivalents. Nonetheless, the Federal Circuit affirmed the district court’s refusal to apply the  
21    doctrine of prosecution history estoppel to bar plaintiff’s doctrine of equivalents argument,  
22    reasoning that “the narrowing amendment in this case was for the purpose of distinguishing the  
23    invention over Everson. *Insituform* made it clear that the difference between its process and  
24    Everson was that its process did not have the disadvantage of the Everson process of a large  
25    compressor at the end of the liner. There is no indication in the prosecution history of any  
26    relationship between the narrowing amendment and a multiple cup process, which is the alleged  
27    equivalent in this case. Thus, we hold that plaintiffs have successfully rebutted the *Festo*  
28    presumption by establishing that the amendment narrowing the claimed invention from multiple



1 cups to a single cup was tangential to accused Process 1, which used multiple cups attached at  
2 different points along the liner tube.” 385 F.3d at 1369-70.

3 Here, the narrowing language on which Zinus bases its prosecution history estoppel  
4 defense involves narrowing the subject of the patented method from generic “compressed  
5 articles” to a specific mattress assembly “of coiled springs wherein each spring is contained  
6 within an individual pocket of fabric.” [See Motion for Reconsideration at 11; Summary  
7 Judgment Reply at 2-3] As discussed in detail in the Statement of Facts, the purpose of this  
8 amendment was to distinguish the claimed inventions from the Broyles prior art reference, which  
9 was not used on a mattress assembly “of coiled springs wherein each spring is contained within  
10 an individual pocket of fabric.” There is no indication in the prosecution history of any  
11 relationship between the narrowing amendment and the use of a structure like the Zinus fabric  
12 and tape combination to restrict the compressed assembly from expanding during shipping. Thus,  
13 as was the case in *Insituform*, Dreamwell has successfully rebutted the presumption of  
14 prosecution history estoppel as a matter of law by establishing that the narrowing amendments are  
15 at most tangentially related to the subject matter of Dreamwell’s equivalence argument.

16 **2. There Are at Least Triable Issues of Fact Relating to Whether**  
17 **Dreamwell Is Entitled to the Unforseeability Exception to the**  
**Presumption of Prosecution History Estoppel.**

18 Zinus argues for the first time in its Motion for Reconsideration that Dreamwell is not  
19 entitled to rely on the unforseeability exception to the prosecution history estoppel defense  
20 because the combination of a sheet of reinforced fabric and banding tape or plastic stripping was  
21 known in the prior art. Specifically, Zinus asserts that this combination was present in U.S.  
22 Patent No. 4,711,067, also referred to as the “Magni Patent,” and that Zinus is merely practicing  
23 the prior art. Once again, this argument is based on a fundamental misreading of the Magni  
24 reference.

25 In particular, Zinus again misrepresents at page 12 of its Motion for Reconsideration that  
26 like Zinus, in the Magni Patent, the compressed mattress (which is not a pocketed coil innerspring  
27 mattress of the type claimed in the ‘142 Patent) is “rolled up together with a *sheet*” of “film,”  
28



1 which in turn is held together with “ribbon-shaped strings.” However, unlike the Zinus Swirl  
 2 Wrap process, which uses a contiguous sheet of reinforced fabric that covers or surrounds a  
 3 substantial portion of the exposed surface of the mattress and (along with the tape or bands)  
 4 restricts the compressed mattress from expanding, the Magni patent discloses rolling up the  
 5 mattress with one or more “convolutions”<sup>9</sup> of “a *ribbon shaped* film 222” that does not cover or  
 6 surround a substantial portion of the exposed surface of the mattress. [Exh. W-A (Magni patent  
 7 5:66, 6:30-31, 6:58-59 (emphasis added) (all specifically referring to “ribbon-shaped film  
 8 222”))] <sup>10</sup> This distinction is discussed in detail at pages 20-24 of Dreamwell’s Opposition to the  
 9 original Summary Judgment motion.

10 Zinus’ mischaracterization of the Magni Patent is highlighted in Figure 13 of the Patent,  
 11 which Zinus relies on and reproduces at page 5 of its Summary Judgment Reply Memorandum.  
 12 Zinus suggests that this figure shows a sheet of film that covers the compressed mattress. But a  
 13 careful examination of the figure and the related text in the patent reveals that the portion of the  
 14 figure labeled as 222A does not represent a sheet of film; rather, it refers to an “outside  
 15 convolution 222A of ribbon shaped film 222.” [Exh. W-A (Magni patent 6:29-31)] Figure 13  
 16 also labels and points to an item “C”, which the patent discloses is the cover for the mattress.  
 17 [Exh. W-A (Magni patent, 4:29-37)] There would be no reason to label the cover for the mattress  
 18 if it was not visible after application of the “convolution” or “convolutions” of “ribbon-shaped  
 19 film 222.” Thus, properly understood, Figure 13 discloses a process that involves wrapping a  
 20 compressed mattress in a criss-cross pattern with one or more revolutions of a narrow, ribbon-  
 21 shaped strand of film. There is simply is no disclosure in Figure 13 (or anywhere else in the  
 22 Magni Patent) of using a solid sheet of fabric or other material that extends beyond and covers or  
 23 surrounds a substantial portion of the exposed surface of the mattress to restrict the mattress from  
 24 expanding during shipping.

25 \_\_\_\_\_  
 26 <sup>9</sup> A “convolution” is commonly defined as “a turn of anything coiled.” [Wilson Decl. Exh. 9  
 27 (dictionary.com definition)] Therefore, in this context, the term “at least one outside convolution” means  
 28 that the ribbon-shaped film makes at least one turn around the circumference of the rolled-up mattress

<sup>10</sup> Zinus verified that its rectangular sheet of fabric cannot be considered “ribbon-shaped.”  
 [Wilson Decl. Exh. 2 (Reeves Depo., 24:23-25:1)]

1 In sum, there is absolutely no evidence that the use of combination of a sheet of reinforced  
2 fabric and banding tape or plastic stripping to restrict a compressed pocketed coil mattress from  
3 expanding during shipping was used prior to the '142 Patent, or that such a structure would have  
4 been obvious or foreseeable at the time the original '142 Patent claims were drafted. Indeed, as  
5 noted in Dreamwell's original Opposition papers, the limitation of applying the compression  
6 process to a pocketed coiled mattress was added to distinguish the '142 Patent claims over the  
7 Broyles prior art, and the Patent Office refused to allow issuance of the patent until this limitation  
8 was added. [See Exh. W-F] At the very least, in light of this and other intrinsic evidence that the  
9 proposed equivalent was not foreseeable and the dispute as to the scope and disclosure of the  
10 Magni reference, the resolution of the merits of this factually intensive issue should be postponed  
11 until the record can be more fully developed.

## 12 **II. RESPONSE TO ZINUS' THREE "COMMENTS."**

13 Toward the end of the Motion for Reconsideration, Zinus makes what it refers to as "three  
14 comments with respect to the Court's Order Denying Zinus' Motion for Summary Judgment."  
15 Since Zinus starts its Motion for Reconsideration by proclaiming that the motion "concentrates  
16 on" the prosecution history defense, as opposed to the other reasons that Zinus lists as a basis for  
17 its original motion, it is unclear whether Zinus intends any of these "comments" to serve as a  
18 basis for its motion for reconsideration. Nonetheless, out of an abundance of caution, Dreamwell  
19 will briefly address each of these "comments" in turn.

20 As its first comment, Zinus complains about the Court's finding that issuing a substantive  
21 ruling on Zinus' non-infringement argument at this early stage of the case, before the claims have  
22 been construed, is not feasible. To support this complaint, Zinus reiterates arguments made in its  
23 original moving papers and at the hearing on the original motion. However, it is significant to  
24 note that with respect to Dreamwell's doctrine of equivalents claim, Zinus' argument that an early  
25 resolution is feasible depends on the Court ruling that prosecution history estoppel bars such an  
26 equivalence claim. As noted above, the record before the Court does not support such a ruling.  
27 Accordingly, Zinus' complaint in this regard is without merit.

1           Next, Zinus complains about Dreamwell's contention that Zinus failed to raise the issue of  
2 prosecution history estoppel until its Summary Judgment Reply Brief, and therefore effectively  
3 prevented Dreamwell from addressing this affirmative defense in the context of the original  
4 summary judgment motion. While the record confirms that Dreamwell's contention was  
5 accurate, Zinus' complaint is moot, since Dreamwell has now addressed Zinus' prosecution  
6 history estoppel argument on the merits in this Opposition

7           Finally, Zinus complains about the Court's observation in its Order that the briefing on  
8 Zinus' original motion raised "additional complexity" beyond what Zinus had initially  
9 represented, and about the Court's separate reference to Zinus' argument (articulated for the first  
10 time in its Summary Judgment Reply Brief) that the Swirl Wrap product cannot infringe the '142  
11 Patent under the doctrine of equivalents because it merely practices what was obvious in light of  
12 the prior art Magni Patent. Linking the two observations, Zinus suggests that its "practicing the  
13 prior art" defense does not create complexity because the Court does not have to determine  
14 whether the claims of the '142 Patent is "obvious" in light of the prior art; rather, it only needs to  
15 determine whether an equivalent to those claims is obvious. Zinus' argument is flawed on its  
16 face.

17           Dreamwell submits that even without considering Zinus' "practicing the prior art"  
18 defense, there is more than enough complexity in the issues raised by Zinus' original summary  
19 judgment motion to render a substantive ruling on the merits of that motion premature. Even  
20 setting that complexity aside, however, as Zinus itself points out in its third "comment," to grant  
21 Zinus' motion that the Magni Patent precludes Dreamwell's doctrine of equivalents claim, the  
22 Court would have to find that "the elements of the claims of the '142 Patent, including an  
23 expanded equivalency of the 'inserting' claim element, would have been obvious over the Magni  
24 patent." While Zinus correctly notes that such a determination does not require an additional  
25 finding that the literal scope of the claims of the '142 Patent would have been obvious in light of  
26 the Magni reference, the complexity in determining whether equivalents of the '142 Patent are  
27 obvious in light of Magni are no less complex than that determination, and no more susceptible to  
28 summary determination.

1 To be clear, as Dreamwell described in detail at pages 20-24 of its Summary Judgment  
2 Opposition, there are substantial differences between the Magni Patent and the '142 Patent (or  
3 claimed equivalents) that preclude the Court from resolving on summary judgment the fact-  
4 intensive question of whether the claims of the '142 Patent or their equivalent (as practiced by  
5 Zinus) are obvious in light of the Magni Patent.<sup>11</sup> In particular, the claims of the '142 Patent are  
6 expressly limited to "[a] method of packaging a mattress assembly constructed of coil springs  
7 wherein each spring is contained within an individual pocket of fabric," while the Magni Patent  
8 does not disclose packaging of an innerspring mattress with individual pocket coils; indeed, Zinus  
9 has not even attempted to argue that this claim limitation is disclosed in Magni.<sup>12</sup> This is a  
10 critical and patentable distinction, as evidenced by the fact that this language was added to  
11 distinguish the claims over the Broyles prior art, and the Patent Office refused to allow issuance  
12 of the patent until this limitation was added. [See Exh. W-F] The claims of the '142 Patent  
13 require "removing said evacuated tube from said containment sleeve, whereby said mattress  
14 assembly in said tube gradually returns to an uncompressed state," or a step in which "said  
15 evacuated tube is punctured to allow said mattress assembly in said tube to gradually return to  
16 said uncompressed state," or a step in which "said containment sleeve is severed to allow said  
17 mattress assembly in said tube to gradually return to said uncompressed state;" Zinus has not  
18 even attempted to demonstrate that these elements are disclosed in the Magni Patent. And as  
19 discussed in detail above, there is no disclosure in the Magni Patent of a containment sleeve to  
20 retain the compressed mattress in a compressed state for shipping, as claimed in the '142 Patent,  
21 or of using the combination of a solid sheet of fabric and tape or other banding material to  
22 perform the same function as Zinus has done in its Swirl Wrap process.

23  
24  
25 <sup>11</sup> While Dreamwell acknowledges that obviousness is a question of law, it depends on underlying  
26 factual determinations relating to the level of ordinary skill, the scope and content of the prior art, the  
differences between the prior art and the claims at issue, and secondary considerations of non-obviousness  
that make this issue difficult to resolve on summary judgment.

27 <sup>12</sup> Zinus' assertion at page 14 of its Motion that Magni discloses that its process "may be adopted  
28 for many types of mattresses" falls far short of disclosing a method for packaging the specific type of  
mattress covered by the '142 Patent.

1 Boiled down to basics, and notwithstanding Zinus' protestations to the contrary, the Court  
2 got it right in the Order Denying Zinus' Motion for Summary Judgment. Adjudication of the  
3 issues raised by Zinus' original motion is not feasible prior to a claim construction, and it is  
4 certainly not possible to adjudicate those issues in Zinus' favor given the record before the Court.  
5 And with respect to the prosecution history estoppel issues raised for the first time in Zinus'  
6 Summary Judgment Reply, while those issues may be resolved prior to claim construction, the  
7 record establishes that they must be decided in Dreamwell's favor.

8 **Conclusion**

9 For the foregoing reasons, Zinus' Motion for Reconsideration should be denied.

10 DATED: January 8, 2008

**PERKINS COIE LLP**

11 By \_\_\_\_\_/s/  
12 Kenneth B. Wilson

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